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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,760	01/05/2004	Paolo Manini	6023-173US(BX2500M)	5621

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AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103-7013

EXAMINER

HOOK, JAMES F

ART UNIT	PAPER NUMBER
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3754

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,760

Applicant(s)

MANINI ET AL.

Examiner

James F. Hook

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The amendment filed December 1, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: in claim 14, the specification does not appear to support the combination of the use of an evacuated panel containing polymeric material which "further contains a getter material" where the specification appears to only support getter material or polymeric material alone, not a combination of the two in a single layer as the language of the claim recites, also claims 17-19 recite "polymeric foam" where the specification does not appear to support the term "foam" in the specification as originally filed.

Applicant is required to cancel the new matter in the reply to this Office Action.

The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d

577, 179 USPQ 167 (CCPA 1973). As set forth above, and in MPEP 608.01 (p), incorporation of essential material by reference is only allowed in US patent applications when referring to other US patents or patent applications. The fact that an English version exists does not allow for the use of incorporation by reference of a foreign publication of essential subject matter, therefore this must still be addressed in any subsequent responses, where applicants arguments directed toward this issue suggest that the incorporation by reference is intended to cover essential material.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14 and 17-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As set forth above, the originally filed specification does not set forth the combination of a "getter material" and a polymeric material in a single layer, or the term "foam" as recited in claims 17-19.

It is noted that for a proper rejection to be made as clearly anticipated by a reference, the examiner is not required to set forth the basis for this rejection, especially

in cases where applicant has received an explanation of the relevance of this reference in the PCT application, however, the examiner will explain the reference below to clarify the reference for the applicant, even though the examiner believes this reference to clearly anticipate the claims rejected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 11, 12, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Eyhorn. The patent to Eyhorn discloses the recited heat insulation system for tubular bodies comprising at least two superimposed panels with staggered joints (col. 4, lines 30-44), where the panels are evacuated (col. 3, lines 18-30), such is used on a pipe (col. 3, lines 10-17), foil can be used to form the panel outer layers (col. 3, lines 31-57), fillers can be provided including mica (col. 4, lines 1-2), organic and inorganic materials are used to form the insulating material within the evacuated panels (col. 3, lines 58-67), where the panels are rolled around the pipe to insulate it, and the fact that each panel consists of both inorganic material and organic material up to 50%, there are at least two panels made of material which includes inorganic and organic materials, provides that there is one panel with inorganic material in, it and one panel with organic material in it, where the term consisting essentially of is considered

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equivalent to comprising when applicants layers also contain various other additives, and the fact that the art teaches at least 50% of each which is considered to form a considerable part of the layer (see MPEP 2111.03 for the interpretation of "consisting essentially of"), where the foil layer is between lamina, and where inherently the material filling the evacuated panels is inherently a getter material which is mixed with a polymeric material.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter in view of Hughes. The patent to Hunter discloses the recited heat insulation system which can be used on a pipe comprising at least two superimposed evacuated panels which can be formed by an envelope containing a discontinuous or porous filling material, where one pane comprises polymeric filling material and another evacuated panel comprises inorganic filling material, where the polymeric material can be foam including open cell polyurethane foam, the inorganic material can be glass fibers or silica powder, where the use of specific sized particles are consider to be merely a choice of mechanical expedients requiring only routine experimentation to arrive at optimum values for the material used, and where at least one envelope can be provided with barrier sheets including multilayer sheets such as

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metalized plastic layers or metal foil. The patent to Hunter discloses all of the recited structure with the exception of stating how the insulation is provided on a pipe, specifically rolling the layers around a longitudinal axis, where the inner and outer layer seams are offset, and to use a specific type of silica, specifically pyrogenic silica. The patent to Hughes discloses the recited insulation system comprising at least two superimposed panels formed as layers 1, where the insulation layer is wrapped longitudinally around to form the cylindrical shape to be placed over a pipe, where the seams of the layers can be seen in figure 5 to be offset near 4, foil can be provided, and the material used for the insulation can be organic or inorganic and can include silica and glass fibers, where pyrogenic silica can be used as one form of silica used for thermal pipe insulation. It would have been obvious to one skilled in the art to modify the insulation panels in Hunter by winding them around the pipe longitudinally with side edges parallel and opposed to one another, with the seams of the two insulating layers offset, and to modify the silica used to be any usable form of silica including pyrogenic silica as such is a known equivalent form of silica used in pipe insulation systems, as suggested by Hughes as such teaches what is old and known in the art for placing a pair of insulating panels around a pipe to prevent heat escape by offsetting the seams. As set forth above, the use of "consisting essentially of" without any suggestion from the specification of a material only consisting of one material is no more limiting than comprising which allows for other additives to be included in the layer (see MPEP 2111.03).

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter in view of Hughes as applied to claims 1-14 and 17-19 above, and further in view of Hildebrandt. The patent to Hunter as modified discloses all of the recited system with the exception of disposing the insulation between two pipes, and specifically stating the panel containing inorganic material is in contact with the hotter pipe. However, it is suggested by Hunter that one use two different materials for their properties and it is considered an obvious choice of mechanical expedients for one skilled in the art to use routine experimentation to find that placing the panel containing inorganic material against the hotter pipe to as such is a known property of the material to be better utilized in contact with hotter surfaces as such is merely a choice of mechanical expedients to locate the inorganic layer according to its intended use as suggested by Hunter which states using materials based on intended use, where such would prevent the organic material from failing when contacting a hotter surface and thereby saving repair costs. The patent to Hildebrandt discloses that it is old and well known in the art to provide multiple wound insulation panels in an evacuated space between an inner pipe 1 and an outer pipe 12 to better insulate the pipes. It would have been obvious to one skilled in the art to modify the insulation of Hunter as modified by providing an outer pipe to enclose the insulation as suggested by Hildebrandt as such would insulate the inner pipe better and would protect the insulation from damage thereby saving money by reducing repair costs.

Response to Arguments

Applicant's arguments filed December 1, 2004 have been fully considered but they are not persuasive. With respect to the arguments provided against Eyhorn, see the rejection above, where the interpretation of the patent is given as well as an interpretation of the phrase "consisting essentially of", and the patent to Eyhorn stills reads upon the claim language, regardless of the disadvantages set forth in applicants specification. As the claims are currently claimed, this reference does meet the claim language with no clear suggestion of what consisting essentially of entails. Arguments are made directed toward using two different types of panels, however, the claim language does not positively recite the panels made of two different types of panels but merely suggests materials used in the two panels. Likewise the claims do not require the weight or expense of the insulation to be reduced, therefore the patent to Eyhorn meets the current claim language. With respect to Eyhorn suggesting damaging the vacuum in one of the panels, such is suggested where three panels exist therefore there would be two panels still remaining in tact, and those layers consist essentially of the required material in evacuated panels. With respect to Hunter, Hunter discloses that two different materials are used (col. 8, lines 41-56 and col. 12, lines 55-65) as well as all the other structure set forth above, therefore Hunter is teaching, especially in the second recitation, that two different insulation elements are used including glasses and open cell polyurethane (col. 12, lines 33-65). Therefore Hunter recites the structure set forth in the rejection. It is noted that applicant states that the references to Hunter and Hughes are not properly combined but offers no reason why other than using different insulating materials which argument is covered above, therefore applicant has not set

forth any specific argument directed toward the combination of references and therefore must be conceding to the appropriateness of this combination.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patent to Perstnev disclosing a state of the art insulated pipe.

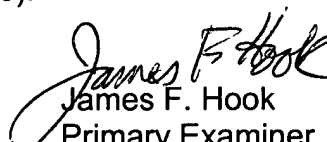
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (571) 272-4903. The examiner can normally be reached on Monday to Wednesday, work at home Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mar can be reached on (571) 272-4906. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


James F. Hook
Primary Examiner
Art Unit 3754

JFH